

## REMARKS

Claims 1, 3-20, 23-27, and 29-35 are pending in the application. In this Response, the applicant makes no claim amendments.

### **A. Response to Rejections under 35 U.S.C. §112**

In paragraphs 3 and 4 of the Office Action, the Examiner rejects claims 30 under 35 U.S.C. §112 for failing to comply with the written description requirement. In response, the applicant submits the Declaration of Dr. Thomas Oakes. The Declaration by Dr. Oakes, the inventor of the claimed invention, describes that a proton exchanging membrane is taught in the application as filed, with the thickness particularly specified (50-125 microns), as well as its function (proton exchange). (*Declaration P. 6*). The application also describes an example membrane as being available from DuPont. (*Declaration P. 6*). Dr. Oakes further states that a person knowledgeable in electrolysis would have understood that DuPont's Nafion product meets these technical and process guidelines. Since Nafion is simply a tradename for sulfonated tetrafluorethylene, it is clear that Dr. Oakes had the invention, and sufficiently described the invention to meet the requirements of §112.

### **B. Response to Rejections under 35 U.S.C. §103**

1. In paragraphs 5 and 6 of the Office Action, the Examiner rejects claims 1, 4-12 and 31-35 under 35 U.S.C. §103(a) as being unpatentable over U.S. publication number 2005/0178427 ("Kelly") in view of U.S. patent number 4,528,252 ("Yamazaki").

In making this rejection, the Examiner has cited to Kelly, which has a US filing date of January 28, 2005, and a claim of priority to a provisional application filed February 18, 2004. However, Dr. Oakes filed a Disclosure Document for this invention with the US Patent and Trademark Office in April 2003, well before Kelly's earliest priority date. The Disclosure Document was assigned

number 529415, and the OIPE “date in” stamp shows it was received at the US Patent Office on April 8, 2003. A copy of the Disclosure Document, showing the Date Stamp and Number, is attached. The Discloser Document number was also referenced in the application as filed.

Since Dr. Oakes has established a priority over Kelly, the applicant respectfully submits that the Examiner should remove Kelly as a reference. Accordingly, the rejected claims are not rendered obvious.

2. In paragraph 7 of the Office Action, the Examiner rejects claims 3 and 15-19 under 35 U.S.C. §103(a) as being unpatentable over U.S. publication number 2005/0178427 (“Kelly”) in view of U.S. patent number 4,528,252 (“Yamazaki”) and in further view of U.S. patent number 5,512,787 (“Dederick”).

As described in section B(1), Dr. Oakes has established a priority over Kelly, and the applicant respectfully submits that the Examiner remove Kelly as a reference. Accordingly, the rejected claims are not rendered obvious.

3. In paragraph 8 of the Office Action, the Examiner rejects claims 13, 14, 23, 26, 27, 29, and 30 under 35 U.S.C. §103(a) as being unpatentable over U.S. publication number 2005/0178427 (“Kelly”) in view of U.S. patent number 4,528,252 (“Yamazaki”) and in further view of U.S. patent number 3,870,616 (“Dempsey”).

As described in section B(1), Dr. Oakes has established a priority over Kelly, and the applicant respectfully submits that the Examiner remove Kelly as a reference. Accordingly, the rejected claims are not rendered obvious.

4. In paragraph 8 of the Office Action, the Examiner rejects claim 20 under 35 U.S.C. §103(a) as being unpatentable over U.S. publication number 2005/0178427 (“Kelly”) in view of U.S. patent number 4,528,252 (“Yamazaki”) and in further view of U.S. patent number 4,052,228 (“Russell”).

As described in section B(1), Dr. Oakes has established a priority over Kelly, and the applicant respectfully submits that the Examiner remove Kelly as a reference. Accordingly, the rejected claims are not rendered obvious.

5. In paragraph 10 of the Office Action, the Examiner rejects claims 24 and 25 under 35 U.S.C. §103(a) as being unpatentable over U.S. publication number 2005/0178427 ("Kelly") in view of U.S. patent number 4,528,252 ("Yamazaki") and in further view of U.S. patent number 5,512,787 ("Dederick").

As described in section B(1), Dr. Oakes has established a priority over Kelly, and the applicant respectfully submits that the Examiner remove Kelly as a reference. Accordingly, the rejected claims are not rendered obvious.

**C. Conclusion**

The applicant respectfully submits that pending claims 1, 3-20, 23-27, and 29-35 are in a condition for allowance. If the Examiner would find it useful, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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